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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,269	10/01/2001	Takashi Sasaki	001458.00014	5401

22907 7590 05/01/2003

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EXAMINER

BERMAN, SUSAN W

ART UNIT PAPER NUMBER

1711

DATE MAILED: 05/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/966,269

Applicant(s)

SASAKI ET AL.

Examiner

Susan W Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1 and 2 filed 10-01-2001 and 1-16 filed 01-23-2003 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Response filed 03-26—2003*

The reply filed on 03-26-2003 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Original claims 1-2, filed 10-01-2001, were drawn to a process for producing a cured film comprising shaping the film, curing by electron beam irradiation and removal of the cured composition. Amended claims 1 and 2 and new claims 3-16 submitted 01-23-2003 are drawn to a resin composition. Since applicant has received an action on the merits for the originally presented invention (original claims 1-2 filed 10-01-2001), this invention (original claims 1 and 2 filed 10-01-2001) has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-16 filed 01-23-2003 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. See 37 CFR 1.111.

Reasons for restriction of the originally presented claims 1-2 filed 10-01-2001 and claims 1-16 filed 01-23-2003 are presented in paper number 9. As stated in paper number 9, applicant has already elected the subject matter of **original claims 1 and 2, as filed 10-01-2001**, by original presentation. Claims 1-16 filed 01-23-2003 have been withdrawn from prosecution as being drawn to a non-elected invention.

As set forth above, since applicant has received an action on the merits for the originally presented invention (**original claims 1-2**), the invention set forth in **original claims 1 and 2** has been constructively elected by original presentation for prosecution on the merits. In response to this paper, applicant should either **resubmit original claims 1 and 2 as claims 17 and 18** for further prosecution on the merits or abandon the instant application. Claims 1-16 might be rejoined with **original claims 1 and 2** upon identifying patentable subject matter in **original claims 1 and 2**, to rejoin claims drawn to a composition and a method for using the composition of the same scope. Alternatively, applicant could file

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a divisional application to prosecute the subject matter of claims 1-16, as submitted on 01-23-2003, which are drawn to a non-elected composition.

Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462.

The fax number for this group is (703) 872-9310 or, for submissions after Final Rejection, (703) 872 9311.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

S B  
April 30, 2003



Susan Berman  
Primary Examiner  
Art Unit 1711